



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,524	08/09/2001	Kiyotaka Matsumoto	500.40472X00	4083
24956	7590	01/24/2006		EXAMINER
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				NGUYEN, TRI V
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/924,524	MATSUMOTO ET AL.
	Examiner	Art Unit
	Tri V. Nguyen	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) 1 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 August 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>Aug. 9 2001</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Priority

1. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Specification

2. The abstract of the disclosure is objected to because the sentence "Image data of the advertisement contents are into advertiser-dedicated page data corresponding to registrant ID and category ID" (lines 3-6) is unclear. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 1 is objected to because of the following informalities: In Claim 1, line 10, the word "of" is misspelled and should be changed to "on." For the purpose of this examination, the word "of" has been interpreted as "on." Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claims 7-12 disclose "an advertisement registration processing section," the exact meaning as to what or whom a "section" refers to is unclear. Also, Claim 8 discloses "an advertisement sending processing unit," the exact meaning as to what or whom the "unit" refers to is unclear.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 7, 8, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by the program suite of "Adfax" and "Adcapture" of FutureTense, Inc. and applied to the "The Boston Globe" website (www.boston.com/globe, hereon referred to as boston.com). Furthermore, the program suite has been described by the published articles of Editor & Publisher (hereon referred to as Editor & Publisher), The Seybold Report Vol. 26, No. 22 (hereon referred to as Seybold 26-22), The Seybold Report Vol. 23, No. 22 (hereon referred to as Seybold 23-22), Business Wire (hereon referred to as Business Wire) and Peter Dyson and Rosanne Rossello (hereon referred to as Dyson).

Regarding Claim 1, Boston.com, Seybold 26-22, Seybold 23-22, Business Wire and Dyson disclose an advertisement contents providing method of displaying, on an information processing apparatus connected to a network, advertisement contents registration of which has been requested from a facsimile apparatus, comprising the steps of:

a) receiving facsimile registration information from said facsimile apparatus of an advertiser, said facsimile registration information indicating a registrant ID, a category ID, and said advertisement contents, and, of advertiser-dedicated page data in an advertisement service/management processing apparatus, storing image data of said advertisement contents into advertiser-dedicated page data corresponding to said registrant ID and said category ID described in said facsimile registration information (Boston.com: page 8, § 1 and pages 12-17; Business Wire: page 1, § 1; Dyson: page 2, § 1-6; Seybold 23-22: page 13, lines § 10-11; page 14, § 1-3 and Seybold 26-22: page 3, § 1-2),

- b) sending a sending request for said advertisement contents from a subscriber-side processing apparatus to said advertisement service/management processing apparatus, said advertisement contents being stored in said advertiser-dedicated page data in said advertisement service/management processing apparatus (Boston.com: pages 4 [see "Classifieds" section], 12-17 and page 19),
- c) reading said advertisement contents from said advertiser-dedicated page data in said advertisement service/management processing apparatus, said advertisement contents being requested from said subscriber-side processing apparatus, and sending said advertisement contents to said subscriber-side processing apparatus which is a request source (Boston.com: page 4 [see the advertisement banner] and page 19 [the "Classified" section]), and
- d) receiving said advertisement contents sent from said advertisement service/management processing apparatus and outputting said advertisement contents to an output device of said subscriber-side processing apparatus (Boston.com: page 4 [see the advertisement banner] and page 19 [the "Classified" section]).

Regarding Claim 2, Boston.com and Editor & Publisher disclose the advertisement contents providing method as claimed in claim 1, wherein, when said facsimile registration information is received, said facsimile registration information is sent back to said facsimile apparatus of said advertiser identified by said registrant ID in said facsimile registration information (Boston.com: page 8, § 2 and Editor & Publisher: page 1, § 6).

Claims 7, 8, 10 and 12 describe a system, an apparatus and a program embodied on a computer readable medium of the method of Claim 1; therefore, the prior arts of Boston.com, Seybold 26-22, Seybold 23-22, Business Wire and Dyson as set forth above are relied upon to reject Claims 7, 8, 10 and 12.

Art Unit: 3622

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston.com in view of Greenberg (WO 00/39657).

Regarding Claim 3, Boston.com discloses the advertisement contents providing method as claimed in claim 1 (Boston.com: pages 4, 12-17 and 19), but does not explicitly teach that wherein characters in said image data of said advertisement contents are recognized so as to generate advertiser-dedicated page data consisting of character data, and when said subscriber-side processing apparatus that has sent said sending request for said advertisement contents is a portable-type information processing apparatus, said generated advertiser-dedicated page data consisting of said character data is sent to said subscriber-side processing apparatus which is said request source. In an analogous art, Greenberg discloses a method wherein the advertisement is composed, stored in a database, sent to a portable device (cell phone) of a subscriber and displayed on the portable device (page 3, lines 3-18; page 6, lines 3-21 and page 7, lines 3-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Boston.com with sending the advertisement to a portable device as taught by Greenberg since it was known in the art that distributing the advertisement to portable device will enhance the effectiveness of the advertisement as the user has more flexibility in accessing the advertisement.

Regarding Claim 4, Boston.com discloses the advertisement contents providing method as claimed in claim 2 (Boston.com: pages 4, 12-17 and 19), but does not explicitly teach that wherein characters in said image data of said advertisement contents are recognized so as to generate advertiser-dedicated page data consisting of character data, and when said subscriber-side processing apparatus that has sent said sending request for said advertisement contents is a portable-type information

Art Unit: 3622

processing apparatus, said generated advertiser-dedicated page data consisting of said character data is sent to said subscriber-side processing apparatus which is said request source. In an analogous art, Greenberg discloses a method wherein the advertisement is composed, stored in a database, sent to a portable device (cell phone) of a subscriber and displayed on the portable device (page 3, lines 3-18; page 6, lines 3-21 and page 7, lines 3-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Boston.com with sending the advertisement to a portable device as taught by Greenberg since it was known in the art that distributing the advertisement to portable device will enhance the effectiveness of the advertisement as the user has more flexibility in accessing the advertisement.

9. Claims 5, 6, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston.com and Editor & Publisher.

Regarding Claim 5, Boston.com and Editor & Publisher disclose the advertisement contents providing method as claimed in claim 1, but do not explicitly teach further comprising the steps of:

- a) sending an inquiry about collection target information from a sales-office-side processing apparatus to said advertisement service/management processing apparatus, said collection target information indicating an advertiser as a collection target of an advertisement usage fee,
- b) receiving said inquiry from said sales-office-side processing apparatus, and making reference to advertiser information indicating information on advertisers that have made said contract to perform advertisement publication on said advertiser-dedicated page in said advertisement service/management processing apparatus, and reading, of said advertisers indicated by said advertiser information, information on an advertiser that is in charge of a sales-office that has made said inquiry, and sending, to said sales-office-side processing apparatus, said read information on said advertiser as said collection target information indicating said advertiser to which said sales-office will perform said collection of said advertisement usage fee,

Art Unit: 3622

- c) receiving said collection target information from said advertisement service/management processing apparatus, and outputting said collection target information to an output device of said sales-office-side processing apparatus,
- d) sending collected information from said sales-office-side processing apparatus to said advertisement service/management processing apparatus, said collected information indicating said advertiser to which said collection of said advertisement usage fee has been performed, and
- e) receiving said collected information from said sales-office-side processing apparatus, and outputting said collected information to an output device of said advertisement service/management processing apparatus.

The Examiner notes that the steps of Claim 5 pertain to standard accounting practices to collect a fee from an advertiser for displaying an advertisement. Boston.com and Editor & Publisher discloses collecting a fee depending on the attributes (length, type, category and frequency) of the advertisement (Boston.com: pages 12-17 and 20-22) by a sales personnel and program (Boston.com: page 23 and Editor & Publisher: page 1, § 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught Boston.com and Editor & Publisher to establish a sales office in communication with a service/management to collect a usage fee for placing an advertisement. One would have been motivated to modify the method to better track the advertisement transactions.

Regarding Claim 6, Boston.com and Editor & Publisher disclose the advertisement contents providing method as claimed in claim 2, but do not explicitly teach further comprising the steps of:

- a) sending an inquiry about collection target information from a sales-office-side processing apparatus to said advertisement service/management processing apparatus, said collection target information indicating an advertiser as a collection target of an advertisement usage fee,
- b) receiving said inquiry from said sales-office-side processing apparatus, and making reference to advertiser information indicating information on advertisers that have made said contract to perform said advertisement publication on said advertiser-dedicated page in said advertisement service/management processing apparatus, and

reading, of said advertisers indicated by said advertiser information, information on an advertiser that is in charge of a sales-office that has made said inquiry, and sending, to said sales-office-side processing apparatus, said read information on said advertiser as said collection target information indicating said advertiser to which said sales-office will perform said collection of said advertisement usage fee,

c) receiving said collection target information from said advertisement service/management processing apparatus, and outputting said collection target information to an output device of said sales-office-side processing apparatus,

d) sending collected information from said sales-office-side processing apparatus to said advertisement service/management processing apparatus, said collected information indicating said advertiser to which said collection of said advertisement usage fee has been performed, and

e) receiving said collected information from said sales-office-side processing apparatus, and outputting said collected information to an output device of said advertisement service/management processing apparatus.

The Examiner notes that the steps of Claim 6 pertain to standard accounting practices to collect a fee from an advertiser for a displaying an advertisement.

Boston.com and Editor & Publisher discloses collecting a fee depending on the attributes (length, type, category and frequency) of the advertisement (Boston.com: pages 12-17 and 20-22) by a sales personnel and program (Boston.com: page 23 and Editor & Publisher: page 1, § 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught Boston.com and Editor & Publisher to establish a sales office in communication with a service/management to collect a usage fee for placing an advertisement. One would have been motivated to modify the method to better track the advertisement transactions.

Claims 9 and 11 describe the advertisement service/management processing apparatus and the sales-office-side processing apparatus of the method of Claim 5; therefore, the prior arts of Boston.com and Editor & Publisher as set forth above are relied upon to reject Claims 9 and 11.

Art Unit: 3622

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. DeLuca et al. (5,870,030) discloses a system for displaying advertisement on a subscriber's pager.

B. Henry (6,424,426) discloses a method for sending advertisement from a facsimile apparatus in the form of a facsimile or e-mail.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

nvt



ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600